

REMARKS

Claims 1-23 and 25-29 are all the claims pending in the application. By this Amendment, Applicant amends claims 12, 20-23, and 25 to further clarify the invention. In addition, Applicant cancels claim 24 and adds claims 26-29.

Applicant thanks the Examiner for initialing the references listed on Form PTO/SB/08 A & B (modified) submitted with the Information Disclosure Statement filed on January 8, 2004.

Summary of the Office Action

The Examiner withdrew the previous rejections. The Examiner, however, found new grounds for rejecting claims 1-25. In particular, the Examiner rejected claims 12, 14, 17-20, 22, and 24 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,366,784 to Hsueh (hereinafter "Hsueh"), claims 1, 3-10, 13, 16, 21, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Hsueh in view of U.S. Patent No. 6,466,799 to Torrey et al. (hereinafter "Torrey"), claims 2 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Hsueh in view of Torrey and Applicant Admitted Prior Art (hereinafter "APA"), and claims 15 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsueh in view of APA. Applicant respectfully traverses these rejections in view of the following remarks.

Claim Rejections under 35 U.S.C. § 102

Claims 12, 14, 17-20, 22, and 24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,366,784 to Hsueh (hereinafter "Hsueh"). Of these rejected

claims only claims 12 and 20 are independent. This response focuses initially on the independent claims 12 and 20.

Claim 12 recites a novel combination of features not taught by the cited reference. For example, amended claim 12 recites “wherein said multifunction telephone is managed by a remote control unit, the remote control unit is notified of an arrived call to said portable radiophone by said multifunction telephone.” Applicant respectfully submits that at least this feature of claim 12 is clearly absent from Hsueh. The Examiner acknowledges this deficiency of Hsueh (see page 5 of the Office Action). Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of independent claim 12 and its dependent claims 14 and 17-19.

Independent claim 20 recites features similar to the features argued above with respect to claim 12. Therefore, claim 20 is patentably distinguishable from Hsueh for at least substantially similar reasons. In addition, independent claim 20 recites: “wherein said multifunction telephone...is switched from a wired line communication mode to a radio communication mode to answer a call addressed to said portable phone via said handset.” Applicant respectfully submits that this feature is clearly absent from Hsueh’s teachings.

The Examiner alleges that Hsueh teaches switching between two types of communication modes as set forth in claim 20 (see page 4 of the Office Action). Applicant has carefully studied the noted paragraphs by the Examiner and Applicant respectfully disagrees. Hsueh addresses the problem of the mobile phone only having a single unit and not having the extension function as regular wire telephone sets. That is, Hsueh addresses the problem of not being able to use the

mobile phone by more than one user at different places and times (col. 1, lines 36 to 43). In particular, Hsueh teaches a telephone set 1 provided with a mobile phone slot 6 into which a mobile telephone 7 can be removably positioned into (Fig. 1; col. 2, lines 35 to 52).

In Hsueh, when the mobile telephone 7 is in the slot 6, the handset 4 of the telephone set 1 can be used instead of the mobile telephone 7 (Fig. 2; col. 3, lines 5 to 18). Moreover, the telephone set 1 with the mobile phone 7 positioned in the slot 6 could also have any number of extension telephone sets connected to it (Fig. 4, col. 3, lines 40 to 55). Thereby, multiple extensions can be provided using a single mobile phone, which is especially useful for the mountains and other rural areas where overhead wires for the wire phones are not available.

In Hsueh, however, the handset 4 receives a call using the wireless network via the mobile telephone 7. In other words, Hsueh's telephone set 1 is not capable of switching between the wired line communication mode and a radio communication mode. In fact, the purpose of Hsueh's teachings is to use wireless communication mode with a telephone set 1 because the telephone set 1 does not have the wired line communication mode.

Hsueh teaches the telephone set 1 receiving the signal of the wireless communication network (col. 2, line 61 to col. 3, line 17). In Hsueh, however, there is no disclosure of the telephone set 1 being able to communicate using the wired communication network in addition to the wireless communication network. For example, in Hsueh, there are no control means to switch between the two types of networks. In fact, the purpose of Hsueh's disclosure is to use the telephone set 1 with a wireless network, where the wired network is not available. In short,

Hsueh clearly fails to disclose having a telephone set configured to switch between a wired communication mode and a radio communication mode.

Therefore, *wherein said multifunction telephone... is switched from a wired line communication mode to a radio communication mode to answer a call addressed to said portable phone via said handset* as set forth in claim 20 is not suggested or taught by Hsueh, which lacks having a telephone set capable of switching between wired and radio communication modes. In fact, in Hsueh, the telephone set communicates only using the wireless network. For at least these additional exemplary reasons, Applicant respectfully submits that independent claim 20 is patentably distinguishable from Hsueh. Applicant, therefore, respectfully requests the Examiner to reconsider and withdraw this rejection of independent claim 20. Also, Applicant respectfully submits that claim 22 is patentable at least by virtue of its dependency on claim 20. Claim 24 is herein canceled, rendering this rejection moot with respect to claim 24.

Claim Rejection under 35 U.S.C. § 103

Claims 1-11, 13, 15, 16, 21, 23, and 25 are rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses this rejection in view of the comments which follow. In particular, claims 1, 3-10, 13, 16-21, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsueh in view of Torrey. Applicant respectfully submits that there is no motivation to combine the references in the manner indicated by the Examiner and that Torrey fails to cure the deficient teachings of Hsueh.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated an artisan to modify a reference or to combine references. *In re Thrif*, 298 F.3d 1357, 1363 (Fed. Cir. 2002).
- b) the proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) the prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless, if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made *as to the reason the skilled artisan, with no knowledge of the*

claimed invention, would have selected these components for combination in the manner

claimed, emphasis added. *Id.*

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” *Kotzab*, 55 USPQ2d at 1316 (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements, emphasis added. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

There is no motivation to combine the references in a manner suggested by the Examiner. The Examiner alleges that one of ordinary skill in the art would have been motivated to include the control unit of Torrey into the system of Hsueh “in order to allow a user to place and receive wireless calls from the standard telephonic devices (page 6 of the Office Action). At the same time, the Examiner alleges that Hsueh teaches placing and receiving wireless calls from the telephone set 1 (see pages 2 and 3 of the Office Action). Since allegedly Hsueh already teaches placing and receiving wireless calls from the standard telephonic devices, then one of ordinary skill in the art would not have been motivated to combine the references in a manner indicated by the Examiner.

In fact, the purpose of Hsueh’s disclosure is to adopt a telephone set 1 to receive wireless calls arriving to the wireless phone. In other words, Hsueh teaches having a plurality of telephone sets 1 receiving and placing calls via one wireless phone. In short, Hsueh already teaches receiving and placing wireless calls using the telephone set 1. That is, there is no purpose to add a control unit of Torrey to perform functions already performed by Hsueh. For at least this exemplary reason, it is respectfully submitted that there is no motivation to combine Hsueh and Torrey in the manner suggested by the Examiner. Therefore, the Examiner cannot fulfill the “motivational” prong of a *prima facie* case of obviousness, as required by *In re Thrif*.

In addition, Torrey fails to cure the deficient teachings of Hsueh. For example, independent claim 1 recites: “wherein said specific multifunction telephone notifies said control unit of a call arrival at said portable radiophone.” The Examiner acknowledges that Hsueh does not teach or suggest a control unit as set forth in claim 1 (see page 5 of the Office Action). The

Examiner, however, alleges that Torrey cures the deficient teachings of Hsueh. Applicant respectfully disagrees.

Torrey teaches a system that allows users to place wireless calls over their hand-held wireless communications device from telephones connected through-out their location, while keeping the convenience and flexibility of a hand-held communications device (col. 2, lines 13 to 18). In particular, Torrey teaches a number of telephonic devices 231-235 (*e.g.*, telephones, facsimile machines, computers) connected to a premises converter 220 for placing and receiving telephonic calls over a wireless network 280 and a telephone network 290. Wireless telephonic calls can be made when hand-held wireless communications device 200 is located in premises station 210, which can either be a separate unit, or incorporated into premises converter 220.

In Torrey, the call processor 223, connected to premises station 210 via link 217, exchanges call signaling messages with the hand-held wireless communications device 200, converts incoming signals from the hand-held wireless communications device to incoming signals compatible with the first telephonic device, and converts outgoing signals from the first telephonic device to outgoing signals compatible with the hand-held wireless communications device (Fig. 2A; col. 4, lines 13 to 34).

Torrey, however, teaches using the premises station 210 of the wireless device 200 to notify the call processor 223 of an arriving call. The call processor 223 in its turn forwards the call to an appropriate telephonic device. In other words, Torrey, clearly fails to teach or suggest having a telephonic device notify the alleged control unit (premise converter 220) of the received call. In fact, it is the premises converter which forwards the call to an appropriate telephonic

device. That is, in Torrey, when a call arrives on a wireless device 200, the alleged control unit (premises converter 220) processes the arriving call and forwards it to an appropriate telephonic device.

In short, Torrey fails to teach or suggest a multifunction telephone notifying the control unit of the call which arrived to the portable radiotelephone. Moreover, in Torrey, the portable device is connected to the premise converter 220 and not to the telephonic device. As a result, Torrey clearly fails to teach or suggest notifying the premise converter of the arrived call to the wireless device via telephone device.

Moreover, it appears from page 6 of the Office Action that the Examiner alleges that the call processor 223 is equivalent to the multifunction telephone as set forth in claim 1 (see page 6 of the Office Action, where the Examiner cites col. 5, lines 34 to 49 and col. 6, lines 38 to 54; these passages are related to a call processor 223 processing incoming call of the wireless phone). Assuming *arguendo* that the call processor is a multifunctional telephone, then Torrey clearly fails to teach or suggest a control unit connected to said plurality of multifunction telephones to manage said plurality of multifunction telephones. In fact, in Torrey, there is only one call processor 223, and for at least these reasons it cannot be equated with the plurality of multifunctional telephones.

In addition, if the call processor is equivalent to a multifunctional telephone, then Torrey clearly fails to teach or suggest a control unit, which permits response to an arrived call for said specific multifunction telephone based on an operation state of said specific multifunction telephone. That is, if the call processor is the multifunctional telephone then Torrey does not

teach or suggest the control unit as set forth in claim 1. For at least these exemplary reasons, Applicant respectfully submits that a call processor 223 as taught by Torrey cannot be equated with the a multifunctional telephone as set forth in claim 1. Thus, it is respectfully submitted that with respect to claim 1, the Examiner cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

To sum up, Torrey fails to cure the deficient teachings of Hsueh. Torrey fails to teach or suggest the specific multifunction telephone notifying a control unit of a call arrival at said portable telephone. In fact, neither of the references, either alone or in any conceivable combination, teaches or suggests this feature as set forth in claim 1. Furthermore, there is no motivation to combine the references in a manner indicated by the Examiner. For at least these exemplary reasons, Applicant respectfully submits that claim 1 is patentable over the combined teachings of Hsueh and Torrey. In addition, claims 3-10 are patentable at least by virtue of their dependency on claim 1.

Next, Applicant respectfully traverses this rejection with respect to claims 13 and 16, which depend on claim 12. Claim 12 recites: “wherein said multifunction telephone is managed by a remote control unit, the remote control unit is notified of an arrived call to said portable radiophone by said multifunction telephone.” As explained above, Torrey fails to teach or suggest having a control unit being notified by the telephonic device of a call arrival at the radiophone. Since claim 12 recites features similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here. For at least

substantially the same exemplary reasons, therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claims 13 and 16, which depend on claim 12.

Finally, Applicant respectfully traverses this rejection with respect to claims 21 and 23, which dependent on claim 20. Independent claim 20 recites: “wherein said multifunction telephone notifies said control unit when a call arrives to the portable radiophone, and in response, said control unit switches the multifunction telephone.” Since claim 20 recites features similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here. For at least substantially the same exemplary reasons, therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claims 21 and 23, which depend on claim 20.

Next, Applicant addresses the rejections of claims 2, 11, 15, and 25. Claims 2 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsueh in view of Torrey and further in view of the APA and claims 15 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsueh in view of APA. Applicant respectfully submits that APA teaches that a multifunction telephone cannot receive calls addressed to a radiophone. Therefore, APA fails to teach or suggest a multifunction telephone notifying a control unit of a call received by the radiophone and the control unit switching the multifunction telephone to a different communication mode. As such APA clearly fails to cure the deficient teachings of Hsueh and Torrey. Therefore, claims 2, 11, 15, and 25 are patentable at least by virtue of their dependency on the independent claim 1, 12 or 20.

New Claims

In order to provide more varied protection, Applicant adds claims 26-29. Claims 26-29 are patentable over the prior art references cited by the Examiner at least by virtue of their dependency on claim 20.

• Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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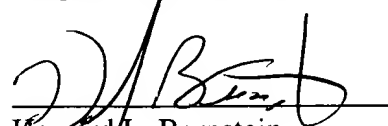
SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Respectfully submitted,



Howard L. Bernstein
Registration No. 25,665

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